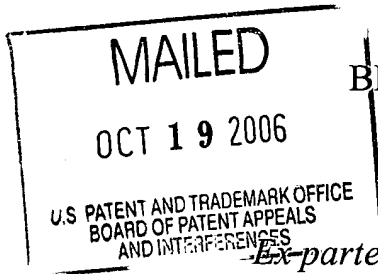


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

~~Ex parte~~ PAUL WANNINGER and ULRIKE JECK-PROSCH

Application No. 10/058,832

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on October 10, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On April 25, 2006, the Examiner mailed an Examiner's Answer. On page 2, section (8) of the Answer entitled "Evidence Relied Upon," the examiner states that "US Patent to Quinlan (3,730,094 is used to illustrate the concept of a caseless cartridge." However, a review of the Answer reveals that the Examiner rejects claims 10, 12, 13, 15, 16, 18, 19 and 21 under 35 U.S.C. § 102(b) as being anticipated by Jacobson et al. (U.S. Patent 3,426,684 or 3,403,625, hereinafter "Jacobson") and claims 11, 14, 17, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Jacobson in view of Watson-Adams (U.S. Patent 4,378,256) and Mosser et al. (U.S.

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Patent 4,724,172).

The Manual of Patent Examining Procedure (MPEP)

§ 1207.02 (8th ed., Rev. 3, August 2005) clearly states:

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, submitted prior art), and, in the case of nonpatent references, the relevant page or pages.

Moreover, the Examiner lists the U.S. patent to Quinlan to “illustrate the concept of a caseless cartridge” in section (8) entitled “Evidence Relied Upon,” and quotes col. 1, ll. 33-41 of Quinlan on page 5 of the Answer. Since this reference was not mentioned in the Examiner’s Final rejection mailed on February 3, 2004, the mention of this reference in the Examiner’s Answer constitutes, possibly, a new ground of rejection. According to MPEP § 1207.03:

37 CFR § 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004. . . . In such an instance where a new ground of rejection is necessary, the examiner should either reopen prosecution or set forth the new ground of rejection in the Answer. The examiner must obtain supervisory approval in order to reopen prosecution.

In addition, any new ground of rejection made by an examiner in the Answer must be approved by a Technology Center (TC) Director or designee, and prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the Answer.

Accordingly, it is

ORDERED that the application is returned to the examiner for

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resolution of the following issues:

(1) vacate the Examiner's Answer mailed on April 25, 2006 to submit a corrected Examiner's Answer identifying the proper "Evidence Relied Upon" in the rejection of claims on appeal,

(2) if appropriate, reopen prosecution to address a new ground of rejection,

(3) if appropriate, obtain approval from a TC Director or appropriate designee for a new ground of rejection; and

(4) for such further action as may be appropriate.

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